

**REMARKS**

No amendments to the claims are made. Applicants thank the Examiner for the courtesy of a telephone conversation on December 17, 2004, and acknowledge the Examiner's statement that the conversation was in response to Applicants' request for clarification of the Office Action only, and was not a formal interview.

**Status of the Claims**

Claims 1-11 are pending. Claims 1-10 are allowed in the Office Action dated October 20, 2004. Claim 11 is withdrawn by the Examiner as a result of a restriction requirement dated November 19, 2003.

In the Office Action dated October 20, 2004, the Examiner stated "Applicant has not canceled the non-elected subject matter with regard to claim 11 and the claim raises new issues under 35 U.S.C. 112, first and second paragraph, thus is not subject to a rejoinder."

Applicants respectfully traverse the Examiner's statement, and request reconsideration and rejoinder of claim 11. Applicants find no basis in the statutes, rules, or MPEP for the Examiner's denial of rejoinder. According to the MPEP, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim **will** be rejoined," (MPEP 821.04, first paragraph, emphasis added). Further, in point #6 of the "Examiner Note" to Form Paragraph 8.43 in MPEP 821.04, the MPEP clearly states "If rejoinder occurs after the first Office action on the merits and if any of the rejoined claims are unpatentable, e.g., if a rejection under 35 U.S.C 112, first paragraph is made, then the next Office

action may be made final since the new ground of rejection was necessitated by the applicant's reply."

The Examiner has improperly applied the rules of rejoinder in stating that Claim 11 is not subject to a rejoinder. According to the MPEP, the proper procedure would be for rejoinder of claim 11 **first**, followed by examination on the merits, rather than an unsupported assertion of unpatentability resulting in a denial of rejoinder.

Therefore, Applicants respectfully request rejoinder of claim 11 to the allowed claims, and a full examination on the merits.

#### **Information Disclosure Statement**

Applicants submitted an Information Disclosure Statement with cited references on April 24, 2002.

In the Office Action dated January 26, 2004, the Examiner indicated that the IDS failed to comply with the requirements because copies of the cited references were not provided, and returned a non-initialed, non-signed copy of the IDS.

In the response of July 23, 2004, Applicants respectfully traversed the Examiner's statement regarding lack of compliance with the rules for submitting an IDS, and provided evidence that the IDS and cited references were properly submitted. Furthermore, in the interest of advancing prosecution, Applicants submitted copies of the references with a second IDS and a Form PTO-1499, and a fee of \$180.

In the Office Action of October 20, 2004, the Examiner failed to acknowledge receipt of the second IDS.

Rather than submit a third copy of the IDS and references cited therein, Applicants respectfully request consideration of the IDS and Form PTO-1499, and references cited therein, properly submitted in the communication of July 23, 2004.

### **Status of Previous Communications**

Applicants submitted an amendment on July 23, 2004 and a supplemental amendment on September 28, 2004. The Office Action of October 20, 2004 acknowledges the communication of July 23, 2004, but does not indicate the status of the September 28, 2004 supplemental amendment. Applicants respectfully request an indication from the Examiner that the supplemental amendment of September 28, 2004 was entered.

### **Response to Claim Objections**

Applicants acknowledge the Examiner's indication that claims 1-10 are allowed, and that the application is in condition for allowance except for formal matters.

The Examiner objects to claim 1 on the basis of clarity, and suggests that claim 1 (a) should be amended to recite "a nucleotide sequence encoding a polypeptide having sugar transport protein activity, wherein said polypeptide is at least 91% identical to SEQ ID NO:32 or 36." The Examiner further states that "for clarity claim (b) needs to recite a function as item (b) cannot encode the protein of item (a) or should be deleted."

Applicants respectfully thank the Examiner for the suggested amendments, but decline to make any changes to the claims at the present time. Applicants disagree that the suggested amendments are necessary, and feel that claim 1 is sufficiently clear for the purposes of 35 USC 112, 2<sup>nd</sup> paragraph. Further, Applicants respectfully traverse the statement that "for

clarity (b) needs to recite a function” (Office Action, page 2). Applicants find no basis in the statutes, rules, or MPEP with the requirement of reciting a function **in the claim**.

Finally, Applicants can find no basis in the statutes, rules, or MPEP for an objection on the basis of clarity. Therefore, Applicants respectfully request allowance of this application. If the Examiner declines to allow the application, then Applicants request withdrawal of the Quayle action, and reopening of prosecution on the merits.

### CONCLUSION

Applicants thank the Examiner for the indication that claims 1-10 are allowed. Based on the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the objection to the claims and allowance of this application.

### AUTHORIZATION

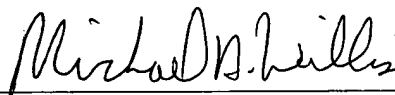
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 2119-4263. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 2119-4263. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: December 20, 2004

By: \_\_\_\_\_



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